

B12-01
ADR ECF

JS 44 CAND (Rev. 12/11)

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON NEXT PAGE OF THIS FORM.)

I. (a) PLAINTIFFS

Jackson Family Wines, Inc.

(b) County of Residence of First Listed Plaintiff

(EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorneys (Firm Name, Address, and Telephone Number)
Dickenson, Pealman & Fogarty

809 Coombs Street
Napa, CA 94559
707-252-7122

DEFENDANTS

Fine Estates From Spain, Inc.

County of Residence of First Listed Defendant

Norfolk County

(IN U.S. PLAINTIFF CASES ONLY)

NOTE:

IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE TRACT OF LAND INVOLVED.

Attorneys (If Known)

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

1 U.S. Government Plaintiff

Federal Question
(U.S. Government Not a Party)

2 U.S. Government Defendant

4 Diversity
(Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

Citizen of This State	PTF	DEF	PTF	DEF
<input type="checkbox"/>	<input type="checkbox"/> 1	<input type="checkbox"/> 1	<input type="checkbox"/>	<input type="checkbox"/> 4
<input type="checkbox"/>	<input type="checkbox"/> 2	<input type="checkbox"/> 2	<input type="checkbox"/>	<input type="checkbox"/> 5
<input type="checkbox"/>	<input type="checkbox"/> 3	<input type="checkbox"/> 3	<input type="checkbox"/>	<input type="checkbox"/> 6

Incorporated or Principal Place of Business In This State

IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance	<input type="checkbox"/> PERSONAL INJURY	<input type="checkbox"/> 625 Drug Related Seizure	<input type="checkbox"/> 422 Appeal 28 USC 158	<input type="checkbox"/> 375 False Claims Act
<input type="checkbox"/> 120 Marine	<input type="checkbox"/> 310 Airplane	<input type="checkbox"/> 361 Personal Injury - Product Liability	<input type="checkbox"/> 423 Withdrawal	<input type="checkbox"/> 400 State Reapportionment
<input type="checkbox"/> 130 Miller Act	<input type="checkbox"/> 313 Airplane Product Liability	<input type="checkbox"/> 367 Health Care/ Pharmaceutical Personal Injury	<input type="checkbox"/> 28 USC 157	<input type="checkbox"/> 410 Antitrust
<input type="checkbox"/> 140 Negotiable Instrument	<input type="checkbox"/> 320 Assault, Libel & Slander	<input type="checkbox"/> 368 Product Liability	<input type="checkbox"/> 820 Copyright	<input type="checkbox"/> 430 Banks and Banking
<input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment	<input type="checkbox"/> 330 Federal Employers' Liability	<input type="checkbox"/> 369 Other	<input type="checkbox"/> 830 Patent	<input type="checkbox"/> 450 Commerce
<input type="checkbox"/> 151 Medicare Act	<input type="checkbox"/> 340 Marine Product Liability	<input type="checkbox"/> 820 Copyright	<input type="checkbox"/> 840 Trademark	<input type="checkbox"/> 460 Deportation
<input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans)	<input type="checkbox"/> 343 Marine Product Liability	<input type="checkbox"/> 370 Other Fraud Act	<input type="checkbox"/> 850 Racketeer Influenced and Corrupt Organisations	<input type="checkbox"/> 470 Consumer Credit
<input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits	<input type="checkbox"/> 350 Motor Vehicle	<input type="checkbox"/> 371 Truth in Lending	<input type="checkbox"/> 480 Cable/Sat TV	<input type="checkbox"/> 490 Securities/Commodities/ Exchange
<input type="checkbox"/> 160 Stockholders' Suits	<input type="checkbox"/> 355 Motor Vehicle Product Liability	<input type="checkbox"/> 380 Other Personal Property Damage	<input type="checkbox"/> 550 Other Statutory Actions	<input type="checkbox"/> 550 Other Statutory Actions
<input type="checkbox"/> 190 Other Contract	<input type="checkbox"/> 360 Other Personal Injury	<input type="checkbox"/> 381 Property Damage	<input type="checkbox"/> 891 Agricultural Acts	<input type="checkbox"/> 893 Environmental Matters
<input type="checkbox"/> 195 Contract Product Liability	<input type="checkbox"/> 362 Personal Injury - Med. Malpractice	<input type="checkbox"/> 383 Product Liability	<input type="checkbox"/> 895 Freedom of Information Act	<input type="checkbox"/> 896 Arbitration
<input type="checkbox"/> 196 Franchise		<input type="checkbox"/> 710 Fair Labor Standards Act	<input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant)	<input type="checkbox"/> 899 Administrative Procedure Act/Review or Appeal of Agency Decision
		<input type="checkbox"/> 720 Labor/Mgmt. Relations	<input type="checkbox"/> 871 IRS—Third Party	<input type="checkbox"/> 950 Constitutionality of State Statutes
		<input type="checkbox"/> 740 Railway Labor Act	<input type="checkbox"/> 26 USC 7609	
		<input type="checkbox"/> 751 Family and Medical Leave Act		
		<input type="checkbox"/> 790 Other Labor Litigation		
		<input type="checkbox"/> 791 Empl. Ret. Inc. Security Act		
		<input type="checkbox"/> 861 HIA (1393f)		
		<input type="checkbox"/> 862 Black Lung (923)		
		<input type="checkbox"/> 863 DIWC/DIW (405(g))		
		<input type="checkbox"/> 864 SSID Title XVI		
		<input type="checkbox"/> 865 RSI (405(g))		
		<input type="checkbox"/> 866 FLSA (216)		
		<input type="checkbox"/> 867 COBRA (1132)		
		<input type="checkbox"/> 868 OSHA (1321)		
		<input type="checkbox"/> 869 EEO (2000)		
		<input type="checkbox"/> 870 ERISA (1321)		
		<input type="checkbox"/> 871 FLSA (216)		
		<input type="checkbox"/> 872 COBRA (1132)		
		<input type="checkbox"/> 873 OSHA (2000)		
		<input type="checkbox"/> 874 EEO (2000)		
		<input type="checkbox"/> 875 FLSA (1321)		
		<input type="checkbox"/> 876 COBRA (2000)		
		<input type="checkbox"/> 877 OSHA (1132)		
		<input type="checkbox"/> 878 EEO (1132)		
		<input type="checkbox"/> 879 FLSA (2000)		
		<input type="checkbox"/> 880 COBRA (1132)		
		<input type="checkbox"/> 881 OSHA (2000)		
		<input type="checkbox"/> 882 EEO (2000)		
		<input type="checkbox"/> 883 FLSA (1132)		
		<input type="checkbox"/> 884 COBRA (2000)		
		<input type="checkbox"/> 885 OSHA (1132)		
		<input type="checkbox"/> 886 EEO (1132)		
		<input type="checkbox"/> 887 FLSA (2000)		
		<input type="checkbox"/> 888 COBRA (2000)		
		<input type="checkbox"/> 889 OSHA (1132)		
		<input type="checkbox"/> 890 EEO (1132)		
		<input type="checkbox"/> 891 FLSA (2000)		
		<input type="checkbox"/> 892 COBRA (2000)		
		<input type="checkbox"/> 893 OSHA (1132)		
		<input type="checkbox"/> 894 EEO (1132)		
		<input type="checkbox"/> 895 FLSA (2000)		
		<input type="checkbox"/> 896 COBRA (2000)		
		<input type="checkbox"/> 897 OSHA (1132)		
		<input type="checkbox"/> 898 EEO (1132)		
		<input type="checkbox"/> 899 FLSA (2000)		
		<input type="checkbox"/> 900 COBRA (2000)		
		<input type="checkbox"/> 901 OSHA (1132)		
		<input type="checkbox"/> 902 EEO (1132)		
		<input type="checkbox"/> 903 FLSA (2000)		
		<input type="checkbox"/> 904 COBRA (2000)		
		<input type="checkbox"/> 905 OSHA (1132)		
		<input type="checkbox"/> 906 EEO (1132)		
		<input type="checkbox"/> 907 FLSA (2000)		
		<input type="checkbox"/> 908 COBRA (2000)		
		<input type="checkbox"/> 909 OSHA (1132)		
		<input type="checkbox"/> 910 EEO (1132)		
		<input type="checkbox"/> 911 FLSA (2000)		
		<input type="checkbox"/> 912 COBRA (2000)		
		<input type="checkbox"/> 913 OSHA (1132)		
		<input type="checkbox"/> 914 EEO (1132)		
		<input type="checkbox"/> 915 FLSA (2000)		
		<input type="checkbox"/> 916 COBRA (2000)		
		<input type="checkbox"/> 917 OSHA (1132)		
		<input type="checkbox"/> 918 EEO (1132)		
		<input type="checkbox"/> 919 FLSA (2000)		
		<input type="checkbox"/> 920 COBRA (2000)		
		<input type="checkbox"/> 921 OSHA (1132)		
		<input type="checkbox"/> 922 EEO (1132)		
		<input type="checkbox"/> 923 FLSA (2000)		
		<input type="checkbox"/> 924 COBRA (2000)		
		<input type="checkbox"/> 925 OSHA (1132)		
		<input type="checkbox"/> 926 EEO (1132)		
		<input type="checkbox"/> 927 FLSA (2000)		
		<input type="checkbox"/> 928 COBRA (2000)		
		<input type="checkbox"/> 929 OSHA (1132)		
		<input type="checkbox"/> 930 EEO (1132)		
		<input type="checkbox"/> 931 FLSA (2000)		
		<input type="checkbox"/> 932 COBRA (2000)		
		<input type="checkbox"/> 933 OSHA (1132)		
		<input type="checkbox"/> 934 EEO (1132)		
		<input type="checkbox"/> 935 FLSA (2000)		
		<input type="checkbox"/> 936 COBRA (2000)		
		<input type="checkbox"/> 937 OSHA (1132)		
		<input type="checkbox"/> 938 EEO (1132)		
		<input type="checkbox"/> 939 FLSA (2000)		
		<input type="checkbox"/> 940 COBRA (2000)		
		<input type="checkbox"/> 941 OSHA (1132)		
		<input type="checkbox"/> 942 EEO (1132)		
		<input type="checkbox"/> 943 FLSA (2000)		
		<input type="checkbox"/> 944 COBRA (2000)		
		<input type="checkbox"/> 945 OSHA (1132)		
		<input type="checkbox"/> 946 EEO (1132)		
		<input type="checkbox"/> 947 FLSA (2000)		
		<input type="checkbox"/> 948 COBRA (2000)		
		<input type="checkbox"/> 949 OSHA (1132)		
		<input type="checkbox"/> 950 EEO (1132)		
		<input type="checkbox"/> 951 FLSA (2000)		
		<input type="checkbox"/> 952 COBRA (2000)		
		<input type="checkbox"/> 953 OSHA (1132)		
		<input type="checkbox"/> 954 EEO (1132)		
		<input type="checkbox"/> 955 FLSA (2000)		
		<input type="checkbox"/> 956 COBRA (2000)		
		<input type="checkbox"/> 957 OSHA (1132)		
		<input type="checkbox"/> 958 EEO (1132)		
		<input type="checkbox"/> 959 FLSA (2000)		
		<input type="checkbox"/> 960 COBRA (2000)		
		<input type="checkbox"/> 961 OSHA (1132)		
		<input type="checkbox"/> 962 EEO (1132)		
		<input type="checkbox"/> 963 FLSA (2000)		
		<input type="checkbox"/> 964 COBRA (2000)		
		<input type="checkbox"/> 965 OSHA (1132)		
		<input type="checkbox"/> 966 EEO (1132)		
		<input type="checkbox"/> 967 FLSA (2000)		
		<input type="checkbox"/> 968 COBRA (2000)		
		<input type="checkbox"/> 969 OSHA (1132)		
		<input type="checkbox"/> 970 EEO (1132)		
		<input type="checkbox"/> 971 FLSA (2000)		
		<input type="checkbox"/> 972 COBRA (2000)		
		<input type="checkbox"/> 973 OSHA (1132)		
		<input type="checkbox"/> 974 EEO (1132)		
		<input type="checkbox"/> 975 FLSA (2000)		
		<input type="checkbox"/> 976 COBRA (2000)		
		<input type="checkbox"/> 977 OSHA (1132)		
		<input type="checkbox"/> 978 EEO (1132)		
		<input type="checkbox"/> 979 FLSA (2000)		
		<input type="checkbox"/> 980 COBRA (2000)		
		<input type="checkbox"/> 981 OSHA (1132)		
		<input type="checkbox"/> 982 EEO (1132)		
		<input type="checkbox"/> 983 FLSA (2000)		
		<input type="checkbox"/> 984 COBRA (2000)		
		<input type="checkbox"/> 985 OSHA (1132)		
		<input type="checkbox"/> 986 EEO (1132)		
		<input type="checkbox"/> 987 FLSA (2000)		
		<input type="checkbox"/> 988 COBRA (2000)		
		<input type="checkbox"/> 989 OSHA (1132)		
		<input type="checkbox"/> 990 EEO (1132)		
		<input type="checkbox"/> 991 FLSA (2000)		
		<input type="checkbox"/> 992 COBRA (2000)		
		<input type="checkbox"/> 993 OSHA (1132)		
		<input type="checkbox"/> 994 EEO (1132)		
		<input type="checkbox"/> 995 FLSA (2000)		
		<input type="checkbox"/> 996 COBRA (2000)		
		<input type="checkbox"/> 997 OSHA (1132)		
		<input type="checkbox"/> 998 EEO (1132)		
		<input type="checkbox"/> 999 FLSA (2000)		
		<input type="checkbox"/> 1000 COBRA (2000)		
		<input type="checkbox"/> 1001 OSHA (1132)		
		<input type="checkbox"/> 1002 EEO (1132)		
		<input type="checkbox"/> 1003 FLSA (2000)		
		<input type="checkbox"/> 1004 COBRA (2000)		
		<input type="checkbox"/> 1005 OSHA (1132)		
		<input type="checkbox"/> 1006 EEO (1132)		
		<input type="checkbox"/> 1007 FLSA (2000)		
		<input type="checkbox"/> 1008 COBRA (2000)		
		<input type="checkbox"/> 1009 OSHA (1132)		
		<input type="checkbox"/> 1010 EEO (1132)		
		<input type="checkbox"/> 1011 FLSA (2000)		
		<input type="checkbox"/> 1012 COBRA (2000)		
		<input type="checkbox"/> 1013 OSHA (1132)		
		<input type="checkbox"/> 1014 EEO (1132)		
		<input type="checkbox"/> 1015 FLSA (2000)		
		<input type="checkbox"/> 1016 COBRA (2000)		
		<input type="checkbox"/> 1017 OSHA (1132)		
		<input type="checkbox"/> 1018 EEO (1132)		
		<input type="checkbox"/> 1019 FLSA (2000)		
		<input type="checkbox"/> 1020 COBRA (2000)		
		<input type="checkbox"/> 1021 OSHA (1132)		
		<input type="checkbox"/> 1022 EEO (1132)		
		<input type="checkbox"/> 1023 FLSA (2000)		
		<input type="checkbox"/> 1024 COBRA (2000)		
		<input type="checkbox"/> 1025 OSHA (1132)		
		<input type="checkbox"/> 1026 EEO (1132)		
		<input type="checkbox"/> 1027 FLSA (2000)		
		<input type="checkbox"/> 1028 COBRA (2000)		
		<input type="checkbox"/> 1029 OSHA (1132)		
		<input type="checkbox"/> 1030 EEO (1132)		
		<input type="checkbox"/> 1031 FLSA (2000)		
		<input type="checkbox"/> 1032 COBRA (2000)		
		<input type="checkbox"/> 1033 OSHA (1132)		
		<input type="checkbox"/> 1034 EEO (1132)		
		<input type="checkbox"/> 1035 FLSA (2000)		
		<input type="checkbox"/> 1036 COBRA (2000)		
		<input type="checkbox"/> 1037 OSHA (1132)		
		<input type="checkbox"/> 1038 EEO (1132)		
		<input type="checkbox"/> 1039 FLSA (2000)		
		<input type="checkbox"/> 1040 COBRA (2000)		
		<input type="checkbox"/> 1041 OSHA (1132)		
		<input type="checkbox"/> 1042 EEO (1132)		
		<input type="checkbox"/> 1043 FLSA (2000)		
		<input type="checkbox"/> 1044 COBRA (2000)		
		<input type="checkbox"/> 1045 OSHA (1132)		
		<input type="checkbox"/> 1046 EEO (1132)		
		<input type="checkbox"/> 1047 FLSA (2000)		
		<input type="checkbox"/> 1048 COBRA (2000)		
		<input type="checkbox"/> 1049 OSHA (1132)		
		<input type="checkbox"/> 1050 EEO (1132)		
		<input type="checkbox"/> 1051 FLSA (2000)		
		<input type="checkbox"/> 1052 COBRA (2000)		
		<input type="checkbox"/>		

J. SCOTT GERIEN, State Bar No. 184728
 ALESON R. CLARKE, State Bar No. 261643
 DICKENSON, PEATMAN & FOGARTY
 809 Coombs Street
 Napa, California 94559
 Telephone: (707) 252-7122
 Facsimile: (707) 255-6876

Attorneys for Plaintiff
 JACKSON FAMILY WINES, INC.

E filing
FILED
 APR 19 2012
 RICHARD W. WIEKING
 CLERK, U.S. DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 OAKLAND

Jackson Family Wines, Inc.,

Plaintiff,

vs.

Fine Estates From Spain, Inc.,

Defendant.

CASE NO.

C12-01958

COMPLAINT FOR DECLARATORY RELIEF

Plaintiff, Jackson Family Wines, Inc. ("Plaintiff"), for its complaint against Defendant, Fine Estates From Spain, Inc. ("Defendant"), alleges as follows:

NATURE OF ACTION

1. This is an action for declaratory relief under the Declaratory Judgment Act seeking a declaration of the Court that Plaintiff has not infringed and/or violated any rights of Defendant under the Lanham Act by virtue of Plaintiff's use of the trademark KENDALL-JACKSON AVANT on wine.

THE PARTIES

2. Plaintiff Jackson Family Wines, Inc. is a Delaware corporation with its principal place of business located within this judicial district at 421 Aviation Boulevard, Santa Rosa, California 95403.

3. Upon information and belief, Defendant Fine Estates From Spain, Inc. is a Massachusetts corporation with its principal place of business located at 745 High Street, Dedham, Massachusetts 02026.

JURISDICTION AND VENUE

4. This Court has subject matter jurisdiction over Plaintiff's claim under and pursuant to 28 U.S.C. §2201, as the Defendant's coercive action as set forth in greater detail below necessarily presents a federal question under the federal Lanham Act, 15 U.S.C. §§ 1114, 1125.
 5. Upon information and belief, Defendant, either directly or through its agents, transacted business in the State of California and within this judicial district, as more specifically set forth below, and expected or should reasonably have expected its acts to have consequence in the State of California and within this judicial district.
 6. Venue is proper in this district pursuant to 28 U.S.C. §1331(b), as Defendant is doing business in this judicial district and therefore may be found in this district, and/or as a substantial part of the events giving rise to the claims alleged herein occurred in this judicial district, and/or the asserted infringement occurred in this judicial district.

ALLEGATIONS COMMON TO ALL CLAIMS

7. Plaintiff is a family-owned and family-operated California wine producer that produces and sells a California Chardonnay white wine under the trademark KENDALL-JACKSON AVANT.
 8. On September 15, 2010, Plaintiff received a Certificate of Label Approval from the U.S. Treasury Department's Alcohol and Tobacco Tax and Trade Bureau approving Plaintiff's label for its KENDALL-JACKSON AVANT wine. Plaintiff subsequently began sales of its KENDALL-JACKSON AVANT wine as early as October 8, 2010. Following is an image of the KENDALL-JACKSON AVANT wine label:

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

DICKENSON PEATMAN & FOGARTY



AVANT

FRESH • CRISP • CLEAN

CHARDONNAY
CALIFORNIA
2009

JOHN MACHESNEY STATE & GROWER • FRIEND OF LECTER FOGA COUNTRY IN THE UNITED STATES

9. Plaintiff filed U.S. Trademark Application Serial No. 85/425,094, for KENDALL-
10. JACKSON AVANT for wines on September 16, 2011, based on use of the mark in
11. U.S. commerce since October 8, 2010.
12. Defendant is the owner of U.S. Trademark Registration No. 3,917,662, filed on May
13. 21, 2009, for AVANTE for wine. Defendant's application to register the AVANTE
14. mark was based on intended use, with the first use alleged to have occurred on July 26,
15. 2010. Defendant's registration for AVANTE issued on February 8, 2011.
16. Plaintiff's KENDALL-JACKSON AVANT trademark was examined by the U.S.
17. Patent and Trademark Office which concluded there was no likelihood that the
18. KENDALL-JACKSON AVANT mark would be confused with any trademarks that
19. were the subject of previously-filed trademark applications or registrations, including
20. Defendant's AVANTE mark, and the Trademark Office therefore published Plaintiff's
21. application for opposition on February 7, 2012.
22. Furthermore, upon information and belief, on November 21, 2011, Defendant also filed
23. a Letter of Protest with the Trademark Office objecting to the registration of Plaintiff's
24. application.

1 KENDALL-JACKSON AVANT trademark based on Defendant's AVANTE
2 trademark. On January 3, 2012, the Examining Attorney reviewed the evidence
3 presented in Defendant's Letter of Protest as evidenced by a Notation to the File for
4 Plaintiff's KENDALL-JACKSON AVANT trademark application. Despite
5 Defendant's efforts to show the Trademark Office that its AVANTE mark is
6 confusingly similar to Plaintiff's KENDALL-JACKSON AVANT trademark, the
7 Trademark Office disagreed and concluded there was no likelihood of confusion
8 between the parties' marks, as evidenced by the approval on January 4, 2012, of
9 Plaintiff's KENDALL-JACKSON AVANT trademark application for publication on
10 February 7, 2012.

- 11 13. On March 23, 2012, Defendant filed a Notice of Opposition before the U.S. Patent and
12 Trademark Office Trademark Trial and Appeal Board opposing Plaintiff's KENDALL-
13 JACKSON AVANT trademark application. In its Notice of Opposition, Defendant
14 alleged that it owns U.S. Trademark Registration No. 3,917,662 for AVANTE and that
15 it used the mark in the United States on wine prior to Plaintiff's filing of its trademark
16 application or use of its KENDALL-JACKSON AVANT mark. Defendant further
17 alleges that the parties' marks are confusingly similar. A copy of the Notice of
18 Opposition filed by Defendant on March 23, 2012, is attached hereto as Exhibit A.
19 14. Defendant specifically alleges in its Notice of Opposition that Plaintiff's KENDALL-
20 JACKSON AVANT mark "is substantially and confusingly similar to [Defendant's]
21 registered AVANTE mark" and that Plaintiff's KENDALL-JACKSON AVANT mark
22 "so closely resembles [Defendant's] AVANTE mark as to be likely to cause confusion,
23 mistake, or deception of the relevant trade and public, all to [Defendant's] damage" and
24 that consumers "are likely to believe that [Plaintiff's] goods offered under the mark
25 KENDALL-JACKSON AVANT emanate from, or are licensed or approved by,
26 [Defendant]" and that Defendant "will be damaged by registration of [Plaintiff's]
27 mark."
28

15. Upon information and belief, Defendant's wine under the AVANTE mark is a red wine from Spain made from the Mencia grape variety. Defendant's most current label for its AVANTE wine as reflected in the most recent Certificate of Label Approval issued for the brand appears as follows:



16. Upon information and belief, Defendant's wine labeled with the AVANTE mark is offered for sale and available for purchase in this judicial district.

17. On April 6, 2012, counsel for Defendant sent a letter to Plaintiff objecting to Plaintiff's use of the KENDALL-JACKSON AVANT mark on wine. In the letter, Defendant alleges that the parties' trademarks "are confusingly similar" and demands that Plaintiff never use any mark encompassing the term "AVANT" and that Plaintiff provide an accounting for its sales of the KENDALL-JACKSON AVANT wine. A copy of the letter dated April 6, 2012, from Defendant's counsel to Plaintiff is attached hereto as Exhibit B.

18. Plaintiff has expended a significant amount of time and money in developing its KENDALL-JACKSON AVANT brand and trademark. Plaintiff's brand has already developed extensive momentum since the KENDALL-JACKSON AVANT trademark

1 was first adopted and, since October of 2010, Plaintiff has sold over 2,144,280 bottles
2 of the KENDALL-JACKSON AVANT wine throughout the United States, including
3 over 404,868 bottles in California alone. Plaintiff has also conducted extensive
4 national and regional advertising and promotion for the KENDALL-JACKSON
5 AVANT brand since its launch. The KENDALL-JACKSON AVANT wine has also
6 received significant third party acclaim, winning awards and garnering accolades in
7 major wine publications. *Wine Enthusiast* awarded a score of 90 points to each of
8 the 2009 and 2010 vintages of the KENDALL-JACKSON AVANT wine and
9 named the 2009 KENDALL-JACKSON AVANT wine one of the "Top 100 Best Buys
10 of 2011."

- 11 19. Defendant's claims of likely consumer confusion between the parties' marks have
12 created a reasonable apprehension of liability for Plaintiff and uncertainty for Plaintiff
13 in continuing to invest in its mark and develop its brand.
- 14 20. Defendant alleges that its "AVANTE branded wine has been a marketplace success"
15 and that Defendant has used the AVANTE brand on wine in U.S. commerce since at
16 least July 26, 2010. Despite this, Plaintiff is not aware of any instances of actual
17 confusion in the marketplace between Plaintiff's mark and Defendant's mark in the
18 1-1/2 years since Plaintiff began use of the KENDALL-JACKSON AVANT mark on
19 wine.
- 20 21. The parties' respective marks are different in sight, sound and meaning. Plaintiff's
21 KENDALL-JACKSON AVANT mark features Plaintiff's famous KENDALL-
22 JACKSON house mark which distinguishes it from Defendant's AVANTE mark.
23 Furthermore, the terms AVANT and AVANTE are in different languages and have
24 different meanings, with "avant" being the French word for "before" and "avante"
25 being the Spanish word for "ahead."
- 26 22. The manner in which the parties' respective marks appear to consumers in the
27 marketplace are quite distinct. Plaintiff's KENDALL-JACKSON AVANT mark
28 appears on a yellow bottle with a silver capsule and a cream and silver colored label

1 featuring the famous KENDALL-JACKSON house mark and multicolored grape leaf
2 design with the word AVANT appearing in a dark gray, distinctive, stylized font and
3 the tagline “FRESH • CRISP • CLEAN” appearing in close association therewith,
4 below which appears the Chardonnay varietal designation, the California appellation,
5 the wine vintage and the information that the wine is “100% Jackson Estates Grown”
6 and “Hand Selected From Our Vineyard Estates.” In sharp contrast, Defendant’s
7 AVANTE mark appears on a burgundy colored bottle with a charcoal grey and gold
8 metallic colored capsule and charcoal gray label with a gold metallic border
9 prominently featuring the abstract silhouette profile of four horses’ heads in metallic
10 gold, above which appears the mark AVANTE in metallic gold Times New Roman
11 font, and beneath which appears the equally prominent term “MENCIA” (an obscure
12 Spanish grape varietal unknown to most American consumers) in metallic gold Times
13 New Roman font, along with the wine vintage. Immediately below are images of the
14 parties’ respective packaging featuring the respective marks at issue.

DICKENSON PEATMAN & FOGARTY



1 23. The wines on which the parties' respective marks appear are quite distinct. Plaintiff's
2 KENDALL-JACKSON AVANT mark is used on white wine made from the
3 Chardonnay grape varietal sourced from the Jackson Family estates located in the
4 California appellation. Upon information and belief, Defendant's AVANTE mark is
5 used exclusively on red wine made from the obscure Spanish Mencia grape varietal
6 sourced from the Castilla y León appellation of Spain.

7 24. Plaintiff's KENDALL-JACKSON AVANT mark and Defendant's AVANTE mark are
8 not confusingly similar based on the likelihood of confusion factors considered in
9 determining trademark infringement.

10 **CLAIM UNDER DECLARATORY JUDGMENT ACT**

11 25. An actual controversy has arisen and now exists between the parties relating to
12 Plaintiff's ability to continue use of its KENDALL-JACKSON AVANT trademark
13 without incurring liability to Defendant for infringement of its AVANTE trademark for
14 which Plaintiff desires a declaration of rights.

15 26. A declaratory judgment is necessary in that Plaintiff contends and Defendant denies
16 that consumers are not likely to be confused between Plaintiff's use of its KENDALL-
17 JACKSON AVANT mark on wine and Defendant's use of its AVANTE mark on wine.

18 **PRAYER FOR RELIEF**

19 WHEREFORE, Plaintiff prays for a declaratory judgment against Defendant as follows:

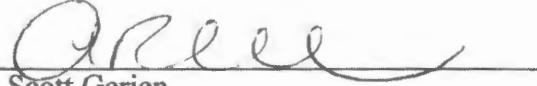
- 20 1. That the Court declare that there is no infringement of Defendant's AVANTE mark
21 by Plaintiff's use of its KENDALL-JACKSON AVANT mark or likelihood of
22 consumer confusion between the parties' respective marks.
- 23 2. That the Court direct the Commissioner of Trademarks to deny Defendant's
24 Opposition No. 91204431 based on the absence of any likelihood of confusion
25 between the parties' marks and to register Plaintiff's KENDALL-JACKSON
26 AVANT mark as set forth in Application Serial No. 85/425,094.
- 27 3. That Plaintiff be awarded its costs, expenses and attorneys' fees incurred herein;
28 and

1 4. For such other and further relief that the Court deems just and proper.

2
3 Dated: 4/19/12

4 Respectfully submitted,

5 DICKENSON, PEATMAN & FOGARTY

6 By 
7 J. Scott Gerien
8 Aleson R. Clarke

9 809 Coombs Street
10 Napa, California 94559
11 Telephone: 707-252-7122
12 Facsimile: 707-255-6876

13 Attorneys for Plaintiff,
14 JACKSON FAMILY WINES, INC.

DICKENSON PEATMAN & FOGARTY

Exhibit A

Trademark Trial and Appeal Board Electronic Filing System. <http://estta.uspto.gov>

ESTTA Tracking number: ESTTA463520

Filing date: 03/23/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Fine Estates From Spain, Inc.
Granted to Date of previous extension	06/06/2012
Address	745 High Street Dedham, MA 02026 UNITED STATES
Attorney information	Aaron Y. Silverstein Saunders & Silverstein LLP 14 Cedar Street, Suite 224 Amesbury, MA 01913 UNITED STATES trademarks@massiplaw.com, asilverstein@massiplaw.com Phone:+1 978-463-9100

Applicant Information

Application No	85425094	Publication date	02/07/2012
Opposition Filing Date	03/23/2012	Opposition Period Ends	06/06/2012
Applicant	Jackson Family Wines, Inc. Legal Department 421 Aviation Blvd Santa Rosa, CA 95403 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. First Use: 2010/10/08 First Use In Commerce: 2010/10/08 All goods and services in the class are opposed, namely: Wines

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3917662	Application Date	05/21/2009
Registration Date	02/08/2011	Foreign Priority Date	NONE
Word Mark	AVANTE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 2010/07/26 First Use In Commerce: 2010/07/26 WINE

Attachments	77742224#TMSN.jpeg (1 page)(bytes) 20120323160109 kendall-jackson avant nop final.pdf (4 pages)(358129 bytes) ex a final.pdf (7 pages)(320665 bytes)
-------------	----------------------------------------------------------------------------------------------------------------------------------------------------------------------

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/asilverstein/
Name	Aaron Y. Silverstein
Date	03/23/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

FINE ESTATES FROM SPAIN, INC.,

Opposer,

v.

JACKSON FAMILY WINES, INC.,

Applicant.

Opposition No.

Application Serial No. 85425094

NOTICE OF OPPOSITION

Fine Estates From Spain, Inc. ("Opposer"), a Massachusetts corporation with a principal place of business at 745 High Street, Dedham, MA 02026, believes that it will be damaged by the registration of the mark KENDALL-JACKSON AVANT, which is the subject of Application Serial No. 85425094 (the "Application"), filed by Jackson Family Wines, Inc. ("Applicant").

The grounds for the opposition are as follows:

1. On September 16, 2011, Applicant filed the subject application to register the mark KENDALL-JACKSON AVANT for:

Class 33: Wines

Applicant has based its application on actual use and claims a date of first use of October 8, 2010.

2. Long prior to the filing date of Applicant's subject application, and the Applicant's alleged date of first use, Opposer adopted the mark AVANTE, and Opposer has since used such mark in interstate commerce continuously and extensively in connection with goods identical to those identified in the Application. Through extensive

advertising, promotion, and use of its AVANTE mark, Opposer has built a strong reputation for high quality goods offered thereunder. Opposer's AVANTE mark has, long prior to Applicant's filing date, and alleged date of first use, come to be distinctive and to uniquely identify Opposer and its goods.

3. Opposer is the owner of the following U.S. trademark registration:

Reg. No.	Mark	Filing Date	Reg. Date
3917662	AVANTE	May 21, 2009	February 8, 2011

A copy of the current status and title of Opposer's above-referenced trademark registration is attached as Exhibit A.

4. The KENDALL-JACKSON AVANT mark of Application Serial No. 85425094 is substantially and confusingly similar to Opposer's registered AVANTE mark.

5. The goods recited in Application Serial No. 85425094 are identical to the goods with which Opposer has used and is using its AVANTE mark, and, on information and belief, Applicant's goods may or will be offered to the same general class of customers to whom Opposer offers its goods under its AVANTE mark.

6. The applied-for KENDALL-JACKSON AVANT mark sought to be registered by Applicant so closely resembles Opposer's AVANTE mark as to be likely to cause confusion, mistake, or deception of the relevant trade and public, all to Opposer's damage.

7. Opposer's customers and potential customers are likely to believe that Applicant's goods offered under the mark KENDALL-JACKSON AVANT emanate

from, or are licensed or approved by, Opposer, when that is not the case. Such confusion would be a source of damage to Opposer.

8. If Applicant is granted the registration herein opposed, it would thereby obtain a *prima facie* right to exclusive use of the KENDALL-JACKSON AVANT mark, which would be a further source of damage to Opposer.

WHEREFORE, Opposer believes that it will be damaged by registration of said mark, and prays that this Opposition be sustained, that Application Serial No. 85425094 be rejected, and that the mark applied for therein be refused registration.

Respectfully submitted,

FINE ESTATES FROM SPAIN, INC.

By its attorneys,



Dated: March 23, 2012

Aaron Silverstein, Esq.
Saunders & Silverstein LLP
14 Cedar Street, Suite 224
Amesbury, MA 01913-1831
P: 978-463-9130
F: 978-463-9109
E: asilverstein@massiplaw.com

CERTIFICATE OF SERVICE

I hereby certify that on March 23, 2012, this Notice of Opposition was served on Applicant by delivering a true and correct copy thereof to the Correspondent of Record listed in Application Ser. No. 79088493 by depositing same with the United States Postal Service, postage pre-paid, via first class mail, addressed to:

JUDITH M. SCVIMMER
JACKSON FAMILY WINES
421 AVIATION BLVD
SANTA ROSA, CA 95403-1069



Aaron Silverstein

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via ESTTA on date shown below to the United States Patent and Trademark Office.



Aaron Silverstein

Date: March 23, 2012

EXHIBIT A

United States of America
United States Patent and Trademark Office

AVANTE

Reg. No. 3,917,662

Registered Feb. 8, 2011

Int. Cl.: 33

TRADEMARK

PRINCIPAL REGISTER

FINE ESTATES FROM SPAIN (MASSACHUSETTS CORPORATION)
745 HIGH STREET
DEDHAM, MA 02026

FOR: WINE, IN CLASS 33 (U.S. CLS. 47 AND 49).

FIRST USE 7-26-2010; IN COMMERCE 7-26-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

THE ENGLISH TRANSLATION OF "AVANTE" IS "BEFORE", "FORWARD", AND "AHEAD".

SN 77-742,224, FILED 5-21-2009.

STEVEN R. FINE, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-03-23 15:42:16 ET

Serial Number: 77742224 [Assignment Information](#)

[Trademark Document Retrieval](#)

Registration Number: 3917662

Mark

AVANTE

(words only): AVANTE

Standard Character claim: Yes

Current Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: 2011-02-08

Filing Date: 2009-05-21

Transformed into a National Application: No

Registration Date: 2011-02-08

Register: Principal

Law Office Assigned: LAW OFFICE 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2010-12-31

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Fine Estates From Spain

3/23/12

Latest Status Info

Address:

Fine Estates From Spain
745 High Street
Dedham, MA 02026
United States

Legal Entity Type: Corporation**State or Country of Incorporation:** Massachusetts

GOODS AND/OR SERVICES

International Class: 033**Class Status:** Active

WINE

Basis: 1(a)**First Use Date:** 2010-07-26**First Use in Commerce Date:** 2010-07-26

ADDITIONAL INFORMATION

Translation: The English translation of "AVANTE" is "before", "forward", and "ahead".

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2011-02-08 - Registered - Principal Register

2011-01-01 - Notice Of Acceptance Of Statement Of Use E-Mailed

2010-12-31 - Law Office Registration Review Completed

2010-12-31 - Assigned To LIE

2010-12-08 - Allowed for Registration - Principal Register (SOU accepted)

2010-11-29 - Attorney Revoked And/Or Appointed

2010-11-29 - TEAS Revoke/Appoint Attorney Received

2010-09-20 - Statement Of Use Processing Complete

2010-08-23 - Use Amendment Filed

2010-09-20 - Case Assigned To Intent To Use Paralegal
2010-08-23 - TEAS Statement of Use Received
2010-06-30 - Notice Of Approval Of Extension Request E-Mailed
2010-06-28 - Extension 1 granted
2010-06-28 - Extension 1 filed
2010-06-28 - TEAS Extension Received
2009-12-29 - NOA Mailed - SOU Required From Applicant
2009-10-06 - Official Gazette Publication Confirmation E-Mailed
2009-10-06 - Published for opposition
2009-09-02 - Law Office Publication Review Completed
2009-09-02 - Assigned To LIE
2009-08-28 - Approved For Pub - Principal Register
2009-08-28 - Examiner's Amendment Entered
2009-08-28 - Notification Of Examiners Amendment E-Mailed
2009-08-28 - Examiners amendment e-mailed
2009-08-28 - Examiners Amendment -Written
2009-08-20 - Assigned To Examiner
2009-05-26 - New Application Office Supplied Data Entered In Tram
2009-05-25 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Aaron Y. Silverstein

Correspondent

Aaron Y. Silverstein
Saunders & Silverstein LLP
14 Cedar St. Ste 224
Amesbury MA 01913
Phone Number: 978-463-9100

3/23/12

Latest Status Info

3/23/12

USPTO Assignments on the Web

http://assignments.uspto.gov/assignments



Assignments on the Web > Trademark Query

No assignment has been recorded at the USPTO

For Serial Number: 77742224

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.3.1
Web interface last modified: Jan 26, 2012 v.2.3.1

| [HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

Exhibit B

4-7-12



Intellectual
Property
Attorneys

SAUNDERS+SILVERSTEIN LLP

AARON SILVERSTEIN
p.978.463.9130
f. 978.463.9109
asilverstein@massiplaw.com

14 Cedar Street, Suite 224
Amesbury, MA
01913

April 6, 2012

Via FedEx
(793428016878)

Judith M. Schwimmer
Jackson Family Wines, Inc.
421 Aviation Blvd
Santa Rosa, CA 95403

Re: *Fine Estates From Spain, Inc. v. Jackson Family Wines, Inc.*
U.S. Trademark Opposition No. 91204431
Our Ref. 400.708/AYS

Dear Ms. Schwimmer,

We represent Fine Estates from Spain, Inc. ("Fine Estates"), owner of U.S. Trademark Registration No. 3,917,662 for the mark AVANTE. The AVANTE trademark is a valuable and important asset of our client's business, and its AVANTE branded wine has been a marketplace success.

As you know, Fine Estates has opposed the application for KENDALL-JACKSON AVANT (Ser. No. 85/425,094), which is owned by Jackson Family Wines, Inc. ("Kendall-Jackson"). In addition to seeking to register this mark, we also understand that Kendall-Jackson has begun using AVANT as a mark for wine in a manner that is clearly separate and distinct from the KENDALL-JACKSON housemark. See Ex. A.

Given the identity of the goods and the near identity of the marks, Fine Estates is confident that the AVANTE and AVANT marks are confusingly similar. The addition of the KENDALL-JACKSON housemark on the label does not lessen the likelihood of confusion. If anything, it heightens the risk that consumers who encounter our client's AVANTE mark will mistakenly believe it is a Kendall-Jackson product. See *A. T. Cross Co. v. Jonathan Bradley Pens, Inc.*, 470 F.2d 689, 692 (2d Cir. 1972) ("Addition of the [housemark] "by Bradley" does not save the day; purchaser could well think plaintiff had licensed defendant as a second user and the addition is thus an aggravation, and not a justification.").

Judith M. Schwimmer
April 6, 2012
Page 2

As such, on behalf of our client, we demand that Kendall-Jackson:

- (1) Voluntarily abandon U.S. Trademark Application Ser. No. 85/425,094;
- (2) Agree never to use or register any mark incorporating the word AVANTE or any word confusingly similar thereto, including but not limited to AVANT, whether alone or in combination with other matter, in connection with alcoholic beverages;
- (3) Provide Fine Estates with a full accounting of goods sold by Kendall-Jackson under the AVANT mark; and
- (3) Provide Fine Estates with documents to show quantities of all current inventory of goods bearing the AVANT mark or any simulation of the AVANT mark.

Should we receive Kendall-Jackson's written assurances by April 20, 2012, that it will comply and provide the requested information, Fine Estates will then be in a better position to discuss how this matter can be fully resolved. Should Kendall-Jackson not comply with the terms of this demand, Fine Estates will exercise all available means to enforce and defend its valuable AVANTE trademark.

This letter is not intended to be a full statement of the facts of this matter, nor is it a waiver of any of Fine Estate's rights or remedies, whether at law or equity, all of which are hereby expressly reserved.

Very truly yours,



Aaron Silverstein

Enclosure
cc: Fine Estates From Spain, Inc.

EXHIBIT A



A FRESH NEW TAKE ON CHARDONNAY

Vivid, crisp and bright, the 2009 Kendall-Jackson Avant Chardonnay continues our nearly three decades of pioneering distinguished varietal wines from California's cool coastal appellations. With flavors that mirror California's fog-laden coastline, this wine achieves a balance of vibrancy and complexity through gentle whole-cluster pressing and fermentation in a combination of older oak barrels and stainless steel. The subtle use of neutral oak adds a graceful structure while cool stainless steel fermentation preserves the fresh, intense fruit flavors inherent to Chardonnay grown along the coastline.

KEY POINTS

- 100% Jackson Estates Grown
- 100% Chardonnay
 - Monterey County contributes lemony citrus and mineral notes.
 - Santa Barbara County delivers fresh pineapple flavors.
 - Mendocino County adds juicy green apple flavors.
- Distinctive flavor profile: fresh, crisp fruit-driven Chardonnay with subtle oak shadings
- Handcrafted in small vineyard lots throughout the entire winemaking process.
- Whole cluster pressed to preserve fresh fruit character.
- 50% fermented in stainless steel; 50% fermented in older oak barrels.
- Partial secondary fermentation gives a rounder mid-palate.
- Avant takes its name from the French word for "before" and reflects the vibrant expression of the fruit before oak has the chance to impart much flavor.

TASTING NOTES

This refreshing Chardonnay bursts with intriguing layers of fresh pineapple, bright green apple, crisp Meyer lemon, juicy pear and wildflowers. The wine's refreshing acidity and sleek mineral notes are balanced by a rounded mid-palate and slight oakiness with a long, pure fruit finish.

STATISTICAL INFORMATION

Appellation: California
Alcohol: 13.5%
T.A.: 0.64
pH: 3.46

GROWING REGIONS

64% Monterey County
35% Santa Barbara County
1% Mendocino County